

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROY RARD

Appeal No. 2003-1640
Application 09/634,692

ON BRIEF

Before WARREN, OWENS and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1, 3, 8, 16 through 18, 20, 21, 23, 25 and 27. Also of record are claims 13 through 15 which were allowed by the examiner, and claims 2, 4 through 7, 9 through 12, 19, 22 and 24 which have been objected to by the examiner with the indication that the same are drawn to allowable subject matter. Claims 1, 16, 20, 23 and 25 are illustrative of the claims on appeal:

1. A rudder assembly for use in a watercraft comprising
a rudder housing having a first side including an inner surface, an outer surface, a leading edge and a trailing edge, and a second side including an inner surface, an outer surface, a leading edge and a trailing edge wherein the first and second sides are in spaced-apart and generally parallel relation to each other, and are joined to each other at their respective leading edges;

a first pair of symmetrical guide members defined by the respective first and second sides of the rudder housing and located at upper portions of each respective side;

a pair of symmetrical hub holes defined by the first and second sides of the rudder housing for receiving a rudder shaft; and

a push rod slidably engageable with the first pair of symmetrical guide members.

16. A foot operated steering assembly for use in a watercraft having a forward end and an aft end that includes a rudder to thereby define an axis, the assembly comprising:

a first track segment;

a first foot brace slidably engageable with the first track segment comprising a track portion;

a first toe control pivotally linked to the first foot brace whereby the toe control is pivotal about an axis substantially orthogonal to the forward-aft axis; and

a first foot brace adjusting means for permitting a user to slidably modify the location of the first foot brace in the first track segment.

20. The steering assembly of claim 16 further comprising a first rudder control cable having a first end and a second end wherein the first end is linkable to a rudder system and the second end is linkable to a mechanical ground wherein a portion of the cable contacts the first toe control and is deflectable thereby during operation of the steering assembly.

23. The steering assembly of claim 20 further comprising a rudder trim adjustment assembly having a housing defining a volume and at least one cable hole, and a rotatable hub sized to fit within the housing volume and having a first cable retention hole defined thereby and means for permitting a user to selectively rotate the hub, wherein the second end of the first cable is locatable in the first cable retention hole defined by the hub and tension in the cable can be increased or decreased by the trim adjustment assembly by rotation of the hub if the first end of the first cable remains stationary.

25. In a watercraft having a cable operated rudder system comprising a rudder linked to a mechanical ground; a first cable extending from the rudder to a rudder control assembly also linked to a mechanical ground; and a second cable extending from the rudder to the rudder control assembly, a rudder trim adjustment assembly mountable to a mechanical ground, comprising:

a housing defining a volume and at least one cable hole; and

a hub sized to fit within the housing volume and having at least one cable retention hole defined thereby and means for permitting a user to selectively rotate the hub wherein at least the first cable engages the hub and the hub remains stationary during operation of the rudder system.

The appealed claims, as represented by the above claims, are drawn to a rudder system suitably illustrated by a portion of the rudder assembly defined by the limitations specified in appealed independent claim 1, and a portion of the foot operated rudder steering assembly

defined by the limitations specified in appealed independent claims 16 and 25. Appealed claims 23 and 25 encompass certain limitations with respect to a rudder trim adjustment assembly of the steering assembly.

The references relied on by the examiner are:

Pelletier	4,231,309	Nov. 4, 1980
Carré et al. (Carré) (published French Patent Application)	2 613 318	Oct. 7, 1988

The examiner has advanced the following grounds of rejection on appeal:
claims 18, 20, 21, 23 and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (answer, pages 3-5);
claims 1, 3 and 8 stand rejected under 35 U.S.C. § 102(b) as anticipated by Pelletier (answer, page 6); and,
claims 16, 17 and 27 stand rejected under 35 U.S.C. § 102(b) as anticipated by Carré (answer, page 6).

Appellant does not group the appealed claims in the brief.¹ Accordingly, we decide this appeal based on appealed claims 1, 16, 18, 20, 21, 23 and 25. 37 CFR § 1.192(c)(7) (2003).

We reverse.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and to appellant's brief and reply brief for a complete exposition thereof.

Opinion

It is well settled that the examiner has the burden of making out a *prima facie* case that the appealed claims do not comply with § 112, first paragraph, written description requirement, by setting forth evidence or reasons why, as a matter of fact, the written description in appellant's disclosure would not reasonably convey to persons skilled in this art that appellant was in possession of the invention defined by the claims, including all of the limitations thereof, at the time the application was filed. *See generally, In re Alton*, 76 F.3d 1168, 1172, 1175-76, 37 USPQ2d 1578, 1581, 1583-84 (Fed. Cir. 1996), citing *In re Wertheim*, 541 F.2d 257, 262-64, 191 USPQ 90, 96-97 (CCPA 1976). It is further well settled that while the written description

¹ We consider the brief filed March 20, 2003 (Paper No. 22).

does not have to describe the invention later claimed *in haec verba*, but such written description “must . . . convey with reasonable clarity to those skilled in the art that . . . [appellant] was in possession of the invention . . . now claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *see also Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000); *Wertheim*, 541 F.2d at 262-65, 191 USPQ at 96-98. Where “the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner or the Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Alton* 76 F.3d at 1175-76, 37 USPQ2d at 1583. In order to establish a *prima facie* case, the examiner or the Board need only establish that as a matter of fact, appellant “claims embodiments of the invention that are completely outside the scope of the specification.” *See Alton* 76 F.3d at 1175-76, 37 USPQ2d at 1583.

We determine that the examiner’s ground of rejection under § 112, first paragraph, is based on the written description requirement because it seems to us that the examiner’s concern is whether the written description of the specification describes “in detail” embodiments specified by the limitations in the appealed claims subject to this ground of rejection (answer, e.g., pages 4, 11, 13, 14 and 16). However, we are of the view that to the extent that the examiner has established a *prima facie* case that the written description in appellant’s disclosure would not reasonably convey to persons skilled in this art that appellant was in possession of the embodiments encompassed by the here rejected appealed claims to one skilled in this art, appellant has submitted rebuttal argument in the brief (pages 9-13) establishing that as a matter of fact, the written description in the specification does establish possession of the embodiments at the time the application was filed with respect to appealed claims 18, 20 and 21.

With respect to appealed claims 23 and 25, we find that, as the examiner points out (answer, pages 16-17), the passage at page 12, lines 4-17, in the specification which describes the function and some structure of “trim adjuster 290” as shown in specification Fig. 11,² taken in light of appellant’s arguments at page 13 of the brief with respect thereto, does not establish that

² We fail to find in appellant’s specification a description of numerals **292**, **294** and **298** associated with “trim adjuster 290” in specification Fig. 11.

appellant was in possession of embodiments of the rudder trim adjustment assembly specified by the limitations in these claims. However, when the same disclosure is considered in light of the description of additional structure for the trim adjustment assembly at page 6, lines 1-11, of the specification, we determine that as a matter of fact on this record, the written description in the specification as a whole is sufficient to reasonably convey to persons skilled in this art that appellant was in possession of such embodiments encompassed by appealed claims 23 and 25, even though certain of the limitations are not set forth in the identical words in these passages of the specification.

Accordingly, we reverse the rejection of appealed claims 18, 20, 21, 23 and 25 under 35 U.S.C. § 112, first paragraph, written description requirement.

Turning now to the grounds of rejection under § 102(b), it is well settled that in making out a *prima facie* case of anticipation under § 102, each and every element of the claimed invention, arranged as required by the claims, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

We find that, when considered in light of the written description in the specification, including the drawings, as interpreted by one of ordinary skill in this art, *see, e.g., In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), the plain language of appealed claim 1 specifies that the rudder assembly comprises, *inter alia*, “a rudder housing” which is shown as numeral **20** in and described with respect to, for example, **Figs. 4** and **6** of the specification (e.g., pages 7-8). The interpretation of this term is the dispositive issue with respect to the ground of rejection of claim 1 over Pelletier which discloses rudder-blade support **4** and bar support **8**, both of which are attached to rudder blade **2**. We find it apparent from the **Figs.** and disclosure at, e.g., col. 3, lines 17-36, of the reference, that it is rudder-blade support **4** which provides the support for

rudder blade **2** as it attaches the same to the boat, while bar support **8** is attached to the aft end of the rudder blade, thus overlaying and supported by the top of the rudder blade. Nonetheless, the examiner contends that the structure of bar support **8** is a “rudder housing” as claimed, because it appears to satisfy other claim limitations, and “claim 1 does not define the rudder housing as supporting a rudder blade and does not define the rudder housing as linking the rudder blade to the watercraft” (answer, pages 7-9). Appellant argues that rudder-blade support **4** is a “rudder housing” because Pelletier’s “rudder assembly could not even be attachable to a watercraft absent its rudder-blade support” (brief, page 7).

In interpreting a claim term, we will give the term its ordinary meaning unless another meaning is intended by appellant as established in the written description in the specification. *See, e.g., Morris, supra; Zletz, supra.* While appellant does not provide an express definition of the term “rudder housing” in the written description in the specification, we find that one of ordinary skill in this art would determine from the specification figures and disclosure that we refer to above, that a “rudder housing” must support the rudder and attach it to the watercraft. This apparent usage in the specification comports with the common, dictionary meaning of the term “housing” in context: “**2. a.** Something that covers, protects, or supports. **b.** A frame, bracket, or box for holding or protecting a mechanical part” *The American Heritage Dictionary, Second College Edition* 625 (Boston, Houghton Mifflin Company, 1982).

Thus, based on our interpretation of the term “rudder housing” in light of the written description in the specification as it would be interpreted by one of ordinary skill in this art, it is apparent to us that it is rudder-blade support **4** of Pelletier with which the limitations of the “rudder housing” specified in appealed claim 1 must be compared. In doing so, we agree with appellants that the reference does not describe the claimed rudder assembly encompassed by appealed claim 1 within the meaning of § 102(b), and accordingly, we reverse the ground of rejection of appealed claims 1, 3 and 8 under this statutory provision.

The dispositive issue with respect to the ground of rejection under § 102(b) based on Carré is whether the reference describes a foot operated steering assembly which has a “first toe control pivotally linked to the first foot brace,” which limitation is present in independent claims 16 and 25. We determine that the quoted claim language considered in light of the written

description in the specification simply and plainly requires that the toe control must pivot at the foot brace in order to affect the steering assembly and direct the watercraft. The specification does not define the term “pivot” or “pivotally,” and we find no basis in the claim language or in the written description in the specification to read any structural limitation(s) from the specification into the claims in this respect. *See Zletz, supra*. Thus, we give the term “pivot” its common, dictionary meaning in context: “**1.** A short rod or shaft around which a related part rotates or swings. . . . **3.** The act of turning on or as if on a pivot.” *The American Heritage Dictionary, Second College Edition* 946 (1982). Accordingly, the toe control is linked to the foot brace in a manner which permits the toe control to be pivoted by the foot. *See, e.g., Morris, supra; Zletz, supra*.

The examiner posits, on the apparent basis of the figure in the 1988 Derwent Publications, Ltd. abstract of Carré,³ that this document shows that “[t]he first toe control is 25. It pivots about axis 23” such that “the first toe control pivotally linked through 23 to the foot brace is 25,” wherein “the first foot brace is 8” (answer, page 6), and that “toe control 25 pivots about the axis defined by axle 23 because of the play in the cable section between pulleys 32 and 33” such that “rod 26 . . . [would pivot] in an upward direction: due to vibration forces in the cable section between pullets 32 and 33; and due to upwardly directed forces which result when a foot slides blade 25 from side to side” (*id.*, page 9). Appellant submits that the figure in the Derwent abstract “appears to clearly show toe control 25 as translating laterally (as indicated by the arrows

³ The examiner specifically cited the published French Patent Application to Carré in the ground of rejection and thus the explanation of the ground of rejection based on the Derwent abstract document is entirely improper. Indeed, appellant states that the examiner supplied *only* the Derwent abstract of the reference and that he responds based on this document (brief, page 8 n.4; reply brief, page 3), and based on the date the translation of the French application was obtained, the Derwent abstract document was in fact relied on by the examiner in the final rejection of May 15, 2002 (Paper No. 12). Ordinarily, this is reversible error because the published application and the abstract are in fact different and independent documents from different entities, each document having its own distinct disclosure and effective date, and thus the ground of rejection must stand or fall on the cited document. However, in this instance, the review of the examiner’s basis for rejection can be appropriately based on consideration of the Derwent abstract alone, which has an applicable publication date. We attached to our decision a copy of the translation prepared at the request of the examiner for the USPTO by FLS, Inc. (February 2003), which we find in the file.

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Graybeal, Jackson, Haley LLP
155 – 108th Avenue NE
Suite 350
Bellevue, WA 98004-5901